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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

In re Application of:

Matthews III, et al.

Serial Number: 09/422,654

Filed: October 22, 1999

For: User Friendly Remote System
Interface With Menu Highlighting

Group Art Unit: 2173

Examiner: B Huynh

Attorney Docket No.: 03797.84665

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Technology Center 2100

This paper of 3 pages is being faxed to 703 872 9306 on
December 31, 2003

Christopher R. Glembocki
Christopher R. Glembocki
Reg. No. 38,800

REQUEST FOR REHEARING UNDER 37 C.F.R. 1.197 (b)

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Commissioner for Patents
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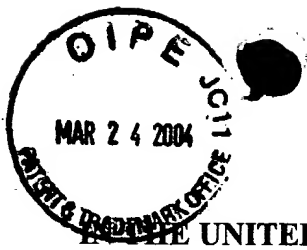
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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Applicants request rehearing under 37 C.F.R. 1.197(b) from the Decision on Appeal of October 31, 2003.

On page 9, lines 9-12, the Board comments on how the Examiner may consider a new reference when applied in combination with the art of record. The Board commented that, in applying the Wiggins reference to new claims,

"The Examiner could also apply an additional reference to show that the size, shape, and spacing of graphical items on a display are



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On page 9, lines 9-12, the Board comments on how the Examiner may consider a new reference when applied in combination with the art of record. The Board commented that, in applying the Wiggins reference to new claims,

“The Examiner could also apply an additional reference to show that the size, shape, and spacing of graphical items on a display are controlled by setting of parameters, which appears to be something that assignee Microsoft could admit to be known.” Emphasis added.

Applicants traverse the last phrase of this sentence. This statement singles out the current assignee of the present application to be held to a higher standard than any other applicant in this area. If the Examiner decides to apply the combination of Wiggins and a new reference against amended claims, then the Examiner is required to establish a *prima facie* case of obviousness

under the procedure described in MPEP 2141-2143. In response, Applicants may traverse the Examiner's asserted *prima facie* case of obviousness on various grounds. The above-quoted language improperly modifies the procedure for establishing *prima facie* obviousness and the manner in which the current Applicants may respond.

The underlined language suggests to the Examiner that a different standard may be applied to the current assignee. In fact, this underlined language may be read as shortcutting the three requirements for establishing the *prima facie* case of obviousness. It changes the three steps from: 1) finding a suggestion or motivation to modify the references, 2) having a reasonable expectation of success, and 3) teaching all claim limitations, to suggesting that any combination made by the Examiner is irrebuttable because the current assignee must admit to that which is known. It in essence requires an admission from the assignee that anything related to "size, shape, and spacing of graphical items on a display are controlled by setting of parameters" is old and well known in the art.

This new procedure eliminates the ability of the present assignee to traverse any reliance on common knowledge or "well known" prior art as described in MPEP 2144.03. Even if the assignee has extensive knowledge of the industry, there is no reason that the assignee should be held to a higher standard than any other Applicant. Rather, claims are determined to be patentable based on the scope and content of the prior art, not on what an Examiner considers to be within the subjective belief of one assignee compared to another. The language of the Decision as it now stands suggests that Examiners may have greater latitude in establishing a *prima facie* case of obviousness in applications assigned to sophisticated or large assignees, because such assignees presumably have a greater ability to admit to what is known in the art. This language closes down the ability for the present assignee to rightfully protect its inventions in this area, while not holding competitors to the same standard of forcibly admitting what the prior art does and does not suggest. This dichotic view of assignees is improper.

Applicants suggest the quoted sentence to be modified as follows:

The Examiner could also apply an additional reference to show that the size, shape, and spacing of graphical items on a display are controlled by setting of parameters.


Or

The Examiner could also apply an additional reference to show that the size, shape, and spacing of graphical items on a display are controlled by setting of parameters, in accordance with the procedure set forth in MPEP 2141-2144.

For these reasons, Applicants request the quoted sentence be modified to not hold the present assignee to a higher standard than set forth in MPEP 2141-2144.

Respectfully submitted,

By:



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Date: December 31, 2003